

STATUS OF CLAIMS

Claims 3, 5-10, 14-25, 27, 29-32 and 35-44 are pending.

Claims 3, 5-10, 14-25, 27, 29-32 and 35-44 stand rejected.

No claims have been amended.

REMARKS

Reconsideration of the subject application is requested.

Rejections Pursuant to 35 U.S.C. 112

Claims 3, 5-10, 14-25, 27, 29-32 and 35-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner states that it is not clear exactly what the term "self-service" in the independent claims, i.e., claims 3 and 25, entails. The Examiner states that for purposes of examination, the Office will broadly interpret this term as meaning that an insured is allowed to submit a claim via a computer system.

In response, Applicant notes that in the Office Action of April 4, 2007, claims 3, 5-10, 14-25, 27, 29-32 and 35-44 were objected to on the grounds that the feature of self-servicing insurance claims is mentioned only in the preamble. The Examiner recommended actively claiming this feature in the bodies of the independent claims. No Section 112 rejection based on the language "self-service" was made.

In response, in the Amendment filed June 21, 2007, the Applicant adopted the Examiner's suggestion and amended claims 3 and 25 to include the "self-service" limitation in the body of the claim. Now, the Examiner has rejected claims 3 and 25 under Section 112, Paragraph 2, based on the precise wording that the Examiner suggested be included in the body of the claim. It is respectfully submitted that the rejection under Section 112, Paragraph 2, as to language specifically suggested by the Examiner, must have been inadvertent, and withdrawal is respectfully requested.

Moreover, the term "self-service" is clear. As stated, for example, on page 8 of the prior response, par. [0016] of the specification teaches that claimants will essentially own the claims and drive the web-based insurance process of the invention.

For at least the foregoing reasons, reconsideration and withdrawal of the rejection under Section 112, Paragraph 2, is respectfully requested.

If the rejection under Section 112, Paragraph 2, is not withdrawn, a more detailed explanation for the rejection is respectfully requested. "If upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C. 112, second paragraph, is appropriate, such a rejection should be made and an analysis as to why the phrase(s) used in the claim is "vague and indefinite" should be included in the Office action." MPEP Section 2173.02. Here, the Examiner has merely included the conclusory statement that it is not entirely clear what the term "self-service" in the independents means. Given the prior approval of this language, and the conclusory rejection, it is not possible for Applicant to submit an amendment to seek to overcome this rejection absent more analysis by the Examiner, as is required by the cited portion of the MPEP.

Rejections Pursuant to 35 U.S.C. 103(a)

Claims 3, 5-10 and 14-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over (1) Borghesi (U.S. Patent 5,950,169), in view of (2) Cutting Out the Middlemen (May 31, 1999 non-patent literature (hereinafter "Middlemen"), further in view of (3) Peterson (US Patent Pub. 2002/0019754), further in view of (4) Automating Collision Claims (May 1994 non-patent literature (hereinafter "Automating") and in even further view of (5) "Personal Progressive" (bearing a date of 4/6/99) (hereinafter "Personal Progressive")

Claims 25, 27, 29-32, 35 and 36 stand rejected on the same grounds as claims 3, 5-10 and 14-15.

Claim 16 stands rejected under 35 U.S.C. 103(a) as being unpatentable over (1) Borghesi in view of (2) Middlemen, further in view of (3) Peterson, further in view of (4) Automating, further in view of (5) Personal Progressive, and yet further in view of (6) progressive.com (dated March 1, 2000).

Claim 17 stands rejected under 35 U.S.C. 103(a) as being unpatentable over (1) Borghesi in view of (2) Middlemen, further in view of (3) Peterson, further in view of (4) Automating, further in view of (5) Personal Progressive, and yet further in view of (6) King (United States Patent No. 5,704,045).

Claims 18 and 19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over (1) Borghesi in view of (2) Middlemen, further in view of (3) Peterson, further in view of (4) Automating, further in view of (5) Personal Progressive and yet further in view of (6) Ryan (United States Patent No. 5,655,085).

Claims 20 and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over (1) Borghesi in view of (2) Middlemen, further in view of (3) Peterson, further in view of (4) Automating, further in view of (5) Personal Progressive, and further in view of (6) King (United States Patent No. 5,704,045), and yet further in view of (7) Ryan, and in even further view of (8) Ertel (United States Patent No. 5,307,262).

Claims 22-23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over (1) Borghesi in view of (2) Middlemen, further in view of (3) Peterson, further in view of (4) Automating, and further in view of (5) Personal Progressive, and yet further in view of (6) Burks (United States Patent No. 6,453,297).

Claim 24 stands rejected under 35 U.S.C. 103(a) as being unpatentable over (1) Borghesi in view of (2) Middlemen, further in view of (3) Peterson, further in view of (4) Automating, further in view of (5) Personal Progressive, and yet further in view of (6) Burks, and in even further view of (7) Ertel.

Claim 37 stands rejected under 35 U.S.C. 103(a) as being unpatentable over (1) Borghesi in view of (2) Middlemen, further in view of (3) Peterson, further in view of (4) Automating, further in view of (5) Personal Progressive and yet further in view of (6) King.

Claims 38 and 39 stand rejected under 35 U.S.C. 103(a) as being unpatentable over (1) Borghesi in view of (2) Middlemen, further in view of (3) Peterson, further in view of (4) Automating, further in view of (5) Personal Progressive, and yet further in view of (6) King, and even in further view of (7) Ryan.

Claims 40-44 stand rejected under 35 U.S.C. 103(a) as being unpatentable over (1) Borghesi in view of (2) Middlemen, further in view of (3) Peterson, further in view of (4) Automating, further in view of (5) Personal Progressive, and yet further in view of (5) King, and yet further in view of (6) Ryan, and in even further view of (7) Ertel.

Applicant requests reconsideration and removal of these rejections for at least the following reasons.

In order to render a claim unpatentable, all of the recited limitations thereof must be taught or suggested in the prior art. *See*, MPEP 2143.03; *see also*, *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Applicant submits the cited prior art fails to teach or suggest each of the limitations of any of the pending claims.

1. *The Cited Art Fails To Teach Or Render Obvious “A Site... Allowing Claimants To Directly Input Information For Insurance Claims For Sustained Losses” as Recited in Claim 3.*

Claim 3 recites, *inter alia*, “[a] computer system comprising: a site generating component generating a site on a global computer network allowing claimants to directly input information for insurance claims for sustained losses.” Notwithstanding that the Office action cites the combined teachings of five (5) separate references (Borghesi, Middlemen, Peterson, Personal Progressive and Automating) to reject Claim 3, these references fail to teach or render obvious such a site generating component.

The Office action first argues Borghesi teaches a site generating component for generating a site for inputting claims from a plurality of sources. *See*, pg. 3, ll. 5-7. However, as set forth in Applicant’s prior response, Borghesi presents a system and method for processing insurance claims “for use by insurance companies as well as appraisers, repair shops, salvage yards and other support industries.” Col. 2, ll. 33-41. Accordingly, Borghesi presents exactly the type of prior art system having the shortcomings and deficiencies that the present invention as recited in Claim 3 addresses by enabling insurance claimants to self-service insurance claims.

The Office Action even acknowledges that Borghesi fails to teach a system that enables claimants to self-service insurance claims, or allows claimants to directly input insurance claims, or includes a claim rehabilitation component. The Office Action attempts to rely on the Peterson reference for these recognized deficiencies in Borghesi. (*See*, pg. 3, ll. 11-18). However, the Office action’s reliance on Peterson in this regard is misplaced, as Peterson fails to remedy these admitted shortcomings of Borghesi.

More particularly, the Office action argues section [0022] of Peterson evidences enabling claimants to self service insurance claims and directly input insurance claims. *See*, pg. 3, ll. 11-14. However, a detailed reading of this section of Peterson fails to support this proposition – and, in fact, actually teaches against an insured or claimant directly entering insurance claims. Section [0022] of Peterson reads, in its entirety:

When the health care provider is satisfied with the status of the claim, it is submitted to the adjudication system, where it is either automatically adjudicated or forwarded to a claims shop for manual review and adjudication. A payment system included in the claims processing systems of the invention initiates payment for approved claims using electronic funds transfer. In the alternative, paper checks may be used to pay the health care provider. (emphasis added)

Thus, the relied upon teachings of Peterson do not teach or suggest having claimants directly enter claim information and/or self-service insurance claims, but instead teaches service provider entered claims. Accordingly, Peterson adds nothing to the deficient teachings of Borghesi in this regard, as, like Borghesi, Peterson instead teaches a system for use by third-party service providers (e.g., appraisers, repair shops, salvage yards and other support industries and health care providers) and not by claimants themselves, as is recited by Claim 3.

The Office Action relies on Section [0050] of Peterson for the alleged teaching of a claim rehabilitation component. The limitation of claim 3 reciting a claim rehabilitation component reads as follows:

a claim rehabilitation component aggregating services related to loss recovery and automatically providing the aggregated services to the claimants to rehabilitate the sustained losses in accordance with said analyzing;

In contrast, Section [0050] of Peterson reads as follows in its entirety:

The elements and functions of auto adjudication system 22 and payment system 24 of FIG. 1 are disclosed in greater detail in FIG. 4. In particular, FIG. 4 illustrates, for purposes of example and not limitation, a procedure whereby a health care provider prepares and submits a claim for payment, after which the claims processing system of the invention adjudicates the claim and initiates payment on the claim if approved. The procedure according to this embodiment begins when an employee in doctor's office 44 requests and receives a claim form from the claims processing system according to the methods that have been described herein. Once the claim form has been received, the health care provider at the doctor's office 44 provides treatment to a patient 46. The diagnosis and treatment are encoded onto the claim form as the claim is prepared for submission. According to one embodiment of the invention that will be described in greater detail hereinafter, the doctor may pretest the claim before submission in order to determine whether the claim is to be automatically adjudicated or manually adjudicated.

The cited Section [0050] of Peterson relates to claims submitted by a health care provider. There is no disclosure in this cited section of Peterson of "aggregating services related to loss recovery"

or “automatically providing the aggregated services to the claimants to rehabilitate the sustained losses in accordance with said analyzing.”

In an apparent effort to address this clear shortcoming of Borghesi and Peterson, the Office Action then vaguely asserts that Middlemen “allows insureds access to services so that they can self-service various insurance transactions”, such that “it would have been obvious ... to have modified the teachings of Middleman so that the system of Middleman would have been able to allow [*sic*] claims to self-service their own insurance claims.” *See, pg. 3, l. 19 to pg. 4, l. 2.*

As an initial matter, the Office Action fails to explain, in any manner whatsoever, how one would combine Middlemen with the combined teachings of Borghesi and Peterson to reach the claimed invention. Instead, the Office Action merely asserts that it would have been obvious to modify Middlemen in the asserted manner. Accordingly, a *prima facie* case of obviousness over the combined teachings of Borghesi, Middlemen, Peterson, Automating and Personal Progressive is lacking.

Should a notice of allowance not be forthcoming, Applicant again requests that the Examiner clearly explain what reliance is being placed upon Middlemen, and how it is being combined with the other cited references, such that Applicant may be afforded a reasonable opportunity to respond thereto.

The above notwithstanding, Applicant further traverses the rejection on the grounds that the asserted modification of Middlemen would not be obvious to one of ordinary skill in the art. Middlemen discusses removing middlemen in the course of buying and selling insurance – not servicing claims. Further, the asserted benefits of Middlemen (reducing paperwork and administrative and sales costs) are explained to be associated with “selling insurance directly on the Internet” and not with any claim servicing activities. In summary, Middlemen is entirely silent regarding servicing claims, and even teaches that eliminating middlemen in certain insurance purchase transactions is not appropriate. Whether or not it would be obvious to allow consumers to purchase insurance without intermediaries to reduce costs and/or improve service fails to provide any motivation or teaching regarding servicing claims relating to sold insurance instruments. Accordingly, Middlemen fails to remedy the deficiency of Borghesi and Peterson, at least with regard to claimants’ claim inputting and self servicing of insurance claims.

For purposes of completeness, Applicant notes that Automating is not relied upon in this regard.

The Office Action then proceeds to rely on Automating for the feature of: "a claim rehabilitation component aggregating services related to loss recovery and automatically providing the aggregated services to the claimants to rehabilitate the sustained losses in accordance with said analyzing." As the Office Action previously stated that Peterson teaches this element, the rejection is confusing, and clarification is respectfully requested. Nevertheless, in order to advance prosecution, Applicant will address this argument as best understood.

However, Automating has no teaching or suggestion of providing aggregated services to claimants. Rather, Automating describes EZNet, which is described as a network that "connects insurers to repair facilities nationwide, and allows them to access a growing group of claims management services." (Automating, page 1, Paragraph 7). Automating also describes the "Integrated Claims Services (ICS), [which] provides carriers with an on-line network of approved repair facilities." (Automating, page 1, paragraph 8). The cited portions of Automating provide that using "EZNet, ICS sends a vehicle directly into repair at pre-approved shops, with standardised rates and procedures. The system can even arrange a replacement rental car for the duration of the repair time." The cited text goes to state: "CCC has also developed a computerized rental car option. Using CARS, otherwise known as the Computerized Auto Rental System, insurers can standardize rental procedures with pre-determined costs and time parameters. Tullman claims computerization can save more than \$100 per claim." It is clear that the EZNet system, as described in Automating, provides services to insurers, not to claimants. Thus, contrary to the assertion in the Office Action, Automated clearly fails to teach at least the limitation "automatically providing the aggregated services to claimants to rehabilitate the sustained losses in accordance with said analyzing."

The Office Action then admits that none of the four references described above provides the limitation:

wherein, the site generating component, claim data analyzing component and claim rehabilitation component enable claimants to self-service the claims for the sustained losses using the aggregated services.

The Office Action asserts that this feature is taught by Personal Progressive (Pages 1-2 and 9).

Personal Progressive appears to be a printout from a secure server (hence the https prefix). Personal Progressive is clearly not published as of April 6, 1999, as, from the file identification, it is confidential information. Moreover, there is no indication in Personal Progressive that Personal Progressive was later published. Accordingly, Personal Progressive is clearly not cited under Section 102(b). Furthermore, Personal Progressive states on page 4: "This is a **sample** estimate." (emphasis in original). Thus, Personal Progressive does not appear to represent a system that provided information about actual estimates.

In short, if this rejection is maintained, the Examiner is respectfully requested to identify the statutory basis for identifying Personal Progressive as a reference, and further to identify how Personal Progressive came to the Examiner's attention, so that Applicant may evaluate whether Personal Progressive qualifies as a reference.

Without admitting that Personal Progressive qualifies as a reference, it is clear that Personal Progressive only provides a tool for communicating with a claims representative via the Internet, as noted on pages 2 and 9 and "information about the status of claims under your policy" as stated on page 1. There is no opportunity provided for claimants to self-service claims, but merely information about the claims. Any actions to be taken regarding the claims evidently must be taken by the claims representative. Accordingly, Personal Progressive clearly does not teach the element:

wherein, the site generating component, claim data analyzing component and claim rehabilitation component enable claimants to self-service the claims for the sustained losses using the aggregated services.

Thus, as Personal Progressive fails to remedy this deficiency of the other references, it is clear that the references, even when combined, fail to teach each limitation of claim 3.

For at least the foregoing reasons, Applicant requests reconsideration and removal of the rejection of Claim 3 under Section 103(a).

Applicant also requests reconsideration and removal of the rejections of Claims 5-10 and 14-24 as well, at least by virtue of these claims' ultimate dependency upon a patentably distinct base Claim 3.

Turning now to Claim 25, it analogously recites, *inter alia*, "generating a site on a global computer network allowing claimants to directly input claimant, insurance and claim information for insurance claims for sustained losses." Accordingly, Applicant also requests reconsideration and removal of the rejection thereof under Section 103.

Applicant also requests reconsideration and removal of the rejections of Claims 27, 29-32 and 35-44 as well, at least by virtue of these claims' ultimate dependency upon a patentably distinct base Claim 25.

2. The Cited Art Fails To Teach Or Render Obvious "Analyzing The Inputted Insurance Claim Information and Identifying the Claimants, Verifying Insurance Coverage And Summarizing the Claims Based on the Analyzing" as Recited by Claim 3.

Notwithstanding that the above-noted deficiency of the cited art is sufficient to require reconsideration and removal of all outstanding rejections under Section 103(a), Applicant further notes that Claim 3 also recites, *inter alia*, "a claim data analyzing component analyzing the inputted insurance claim information and identifying the claimants, verifying insurance coverage and summarizing the claims based on the analyzing." Borghesi, Middlemen, Peterson, Automating and Personal Progressive similarly fail, in any combination, to teach or suggest such an analyzing component.

The Office Action argues Borghesi teaches a claim analyzing component at lines 12-41 of column 13. Applicant traverses this assertion. Applicant instead notes this cited portion of Borghesi merely discusses: the selection of repair parts to prepare an estimate, system event logs and updated and total estimates. Consistently, the cited passages of Borghesi are entirely silent regarding: analyzing the inputted insurance claim information; and identifying the claimants, verifying insurance coverage and summarizing the claims based on the analyzing – as is recited by Claim 3.

For purposes of completeness, Applicant notes the Office action does not rely upon any of Middlemen, Peterson, Automating or Personal Progressive in this regard.

Accordingly, for this additional reason, Applicant requests reconsideration and removal of the rejection of Claim 3 under Section 103.

Applicant also requests reconsideration and removal of the rejections of Claims 5-10 and 14-24 as well, at least by virtue of these claims' ultimate dependency upon a patentably distinct base Claim 3.

Turning now to Claim 25, it analogously recites, *inter alia*, "analyzing the inputted insurance claim information to identify the claimants, verify insurance coverage and summarize

the claims.” Accordingly, Applicant also requests reconsideration and removal of the rejection of claim 25 under Section 103(a).

Applicant also requests reconsideration and removal of the rejections of Claims 27, 29-32 and 35-44 under Section 103(a) as well, at least by virtue of these claims’ ultimate dependency upon a patentably distinct base Claim 25.

3. *The Cited Art, When Properly Considered As A Whole, Fails To Teach Or Suggest The Recited Invention Of Any Of The Pending Claims.*

Notwithstanding that the foregoing represents sufficient grounds that necessarily require removal of all the Office action asserted rejections, Applicant further submits the following grounds justifying reconsideration and removal of the Office action asserted rejections.

Independent Claim 3 recites, *inter alia*, “wherein, the site generating component, claim data analyzing component and claim rehabilitation component enable claimants to self-service the claims for the sustained losses using the aggregated services.” Such a system is disclosed throughout the subject application. The disclosed process is an “open-system” which permits consumers to process their own claims and utilize the ancillary services and commodities offered. The invention permits the claim process to proceed without an agent, broker or an insurance company.

Borghesi presents a comprehensive system and method for processing insurance claims “for use by insurance companies as well as appraisers, repair shops, salvage yards and other support industries.” *Col. 2, ll. 33-41*. Accordingly, Borghesi presents exactly that type of prior art system having the shortcomings and deficiencies that the present invention addresses by enabling insurance claimants to self-service insurance claims.

In an effort to remedy this admitted shortcoming, the Office Action seeks to modify the Borghesi system to enable clients to self-service insurance claims. However, such a modification of Borghesi would eliminate the problem that Borghesi itself seeks to address, namely, that an insurance claim adjuster must spend time keeping track of, and running, separate programs that may overlap and lead to redundant data entry tasks for insurance claim work flow (see, *col. 2, ll. 3-9*). Accordingly, the need for the Borghesi system is entirely eradicated.

In other words, one possessing an ordinary skill in the pertinent art at the time of the invention would not have turned to and sought to modify the Borghesi system, where the problem solved by the Borghesi system (agents processing claims) is not present in the first place. Accordingly, proper grounds to modify the teachings of Borghesi to change its principle of operation are lacking.

In view of the foregoing, Applicant requests reconsideration and removal of the asserted rejection of Claim 3 under Section 103(a), at least on the grounds that the cited prior art fails to teach or suggest at least “[a] computer system ... wherein, the site generating component, claim data analyzing component and claim rehabilitation component enable claimants to self-service the claims for the sustained losses using the aggregated services.”

Applicant also requests reconsideration and removal of the rejections of Claims 5-10 and 14-24 under Section 103(a), at least by virtue of these claims’ ultimate dependency upon a patentably distinct base Claim 3.

Turning now to Claim 25, it analogously recites, *inter alia*, “[a] method ... wherein, the generating, analyzing, aggregating and providing enable claimants to self-service the claims for the sustained losses using the aggregated services.” Accordingly, Applicant respectfully requests reconsideration and removal of the rejection of Claim 25 under Section 103(a) for at least the foregoing reasons.

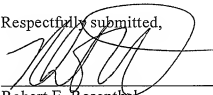
Applicant also requests reconsideration and removal of the rejections of Claims 27, 29-32 and 35-44 under Section 103(a) as well, at least by virtue of these claims’ ultimate dependency upon a patentably distinct base Claim 25.

CONCLUSION -INTERVIEW REQUESTED

Applicant believes he has addressed all outstanding grounds raised in the outstanding Office action, and respectfully submits the present case is in condition for allowance, early notification of which is earnestly solicited.

Should there be any questions or outstanding matters, the Examiner is cordially invited and requested to contact Applicant's undersigned attorney at his number listed below.

Respectfully submitted,



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